03-22-07

IN THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant: Harold W. Milton, Jr.

Appl. No.:   09/273,021

Filed: March 19, 1999

Art Unit: 2627

Examiner: Sanjiv D. Shah

For: SYSTEM FOR FACILITATING THE PREPARATION
         OF A PATENT APPLICATION

Docket No.:   MILT.777 (35322-00004)

TRANSMITTAL OF AMENDED APPEAL BRIEF

MAIL STOP APPEAL BRIEF
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Applicant submits this Amended Appeal Brief in response to the Examiner's Notification of Non-Compliant Appeal Brief mailed by the Board of Appeals on March 12, 2007. It is believed that the brief is now in conformance with 37 C.F.R. § 41.37.

The required fees were originally sent with the initial filing of the Appeal Brief on January 8, 2007. Therefore, no additional fees should be required at this time, however should the Commissioner deem that a fee is necessary the Commissioner is hereby authorized to charge any additional fees or credit any overpayment to Deposit Account No. 04-1061.

Respectfully submitted,

Date: March 21, 2007

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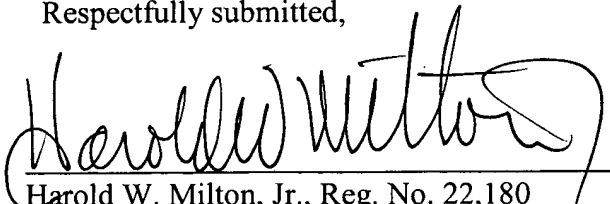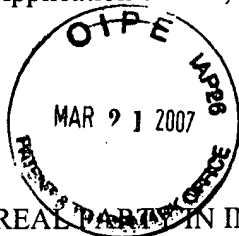OF A PATENT APPLICATION

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Mail Stop Petitions
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AMENDED APPEAL BRIEF

U.S. Application 09/273,021

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BRIEF ON APPEAL

I. REAL PARTY IN INTEREST

The real parties in interest are Harold W. Milton, Jr. and Patent Architect LLC to whom this invention is exclusively licensed. Patent Architect LLC is located at addresses 30726 Sudbury Ct., Farmington Hills, MI 48331 and www.patentarchitect.com.

II. RELATED APPEALS AND INTERFERENCES

There are no appeals or interferences known to Appellant relevant to these proceedings.

III. STATUS OF CLAIMS

Claims 1,3,10, and 19-28 are pending in the application, with claims 1, 19, 20, 21, and 26 being independent. The full text of each claim rejected on prior art is reproduced in the Claims Appendix VIII.

IV. STATUS OF AMENDMENTS

All amendments have been entered.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Dependent claims 3, 10, 22, 24, 25 and 28 will not be argued per se, i.e., separately from independent method claims 1, 19, 21 and independent computer claims 20, 26 and dependent claims 23 and 27, which have antecedent basis in the drawings by reference numerals and in the specification by paragraph (¶) and/or line and page numbers as follows through page 16 hereof:

Claim 1. A method of preparing a patent application with a computer comprising the steps of: (pg. 8, ln 14)

storing (10) a document template in a computer program which contains headings equivalent to: (pg. 4, ln. 11 et seq. and pg. 8, ln 16)

"BACKGROUND OF THE INVENTION

1)   Field of the Invention

2)   Description of the Prior Art

SUMMARY OF THE INVENTION AND ADVANTAGES

BRIEF DESCRIPTION OF THE DRAWINGS

DETAILED DESCRIPTION OF THE PREFERRED EMBODIMENT

CLAIMS

ABSTRACT OF THE DISCLOSURE";

storing a page break immediately before the "CLAIMS" heading in the computer program; (pg. 5, ln 1-2, pg. 8, ln. 18-19)

storing a page break immediately before the "ABSTRACT OF THE DISCLOSURE" heading in the computer program; (pg. 5, ln 3-4, pg. 8, ln. 20-21)

storing a footer in the computer program for displaying the attorney file identification on every page of the application; (pg. 5, ln 7-8, pg. 9, ln. 1-3)

composing by a user an independent claim in the computer program ending in a clause beginning with the words "characterized by" and reciting and isolating the novelty and preceded by at least one clause reciting prior art elements to the extent necessary to support and provide antecedent basis for the "characterized by" clause; (pg. 9, ln 10-15)

drafting claims in the computer ultimately dependent upon the independent claim for successively more specifically defining the patentable novelty; and (pg. 9, ln 16-18)

characterized by storing (14) a duplicate set of all of the claims in the computer program, (pg. 6, ln 16-17. pg. 10, ln. 13-15) and creating the description by retrieving the duplicate set of claims under the heading "DESCRIPTION OF THE PREFERRED EMBODIMENT", (pg. 10, ln 13-17) searching for each occurrence of the

word "said" in the duplicate set of claims copied into the specification, programming the computer program to replace the word "said" with the word "the" in the duplicate set of claims copied into the specification, (pg. 10, ln 17-22) and editing the duplicate set of claims copied into the specification into grammatically correct sentence structure including adding verbs, (pg. 10, ln 21-22) and assigning reference numerals for the first time by the steps (16, 18, 20) of storing the element names of the elements in the order recited in the duplicate set of claims, (pg. 11, ln 8-22) storing successive numbers beginning with a number above the highest Figure number to identify the respective element names, (pg. 12, ln 1-5) and searching for each occurrence of each respective element name in the order of occurrence in the duplicate set of claims, replacing each respective element name with that respective element name followed by successive ones of said numbers to provide identifying reference numerals for the element names in the order of occurrence in the duplicate set of claims (pg. 12, ln 1-5) and automatically shifting the reference numerals in response to changing the order of occurrence in the duplicate set of claims. (pg. 7, ln 17-20)

     Claim 19.   A method of preparing a patent application with a computer characterized by performing the following steps:

     storing (10) a document template in a computer program which contains headings equivalent to, : (pg. 4, ln. 11 et seq. and pg. 8, ln 16)

"BACKGROUND OF THE INVENTION

1)   Field of the Invention

2)   Description of the Prior Art

SUMMARY OF THE INVENTION AND ADVANTAGES

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DETAILED DESCRIPTION OF THE PREFERRED EMBODIMENT

CLAIMS

ABSTRACT OF THE DISCLOSURE";

storing a page break in the computer program immediately before the "CLAIMS" heading; (pg. 5, ln 1-2, pg. 8, ln. 18-19)

storing a page break in the computer program immediately before the heading (pg. 5, ln 3-4, pg. 8, ln. 20-22)

"ABSTRACT OF THE DISCLOSURE";

storing a footer in the computer program for displaying the attorney file identification on every page of the application; (pg. 5, ln 7-8, pg. 9, ln. 1-3)

storing a Figure paragraph in the computer program immediately after the heading "BRIEF DESCRIPTION OF THE DRAWINGS"; (pg. 9, ln 4-5)

storing a terminal paragraph in the computer program stating it is to be understood that reference numerals in the claims are merely for convenience and are not to be in any way limiting immediately before the page break before the heading "CLAIMS"; (pg. 5, ln 11-15 pg. 9, ln. 6-9)

composing by a user an independent claim in the computer program beginning with the words "characterized by" and ending in a clause reciting and isolating the novelty and preceded by at least one clause reciting prior art elements only to the extent necessary to support and provide antecedent basis for the recitations in the "characterized by" clause; (pg. 9, ln 10-15)

composing by a user claims in the computer program ultimately dependent upon the independent claim for successively more specifically defining the novelty; (pg. 9, ln 16-18)

storing **(12)** a duplicate of the independent claim in the computer program, (pg. 10, ln 1-5)

retrieving the stored independent claim under the heading "SUMMARY OF THE INVENTION AND ADVANTAGES", and editing the duplicate independent claim copied under the heading "SUMMARY OF THE INVENTION AND ADVANTAGES" into grammatically correct sentence structure including changing the word "said" to "the" and adding verbs without adding further description whereby the "SUMMARY OF THE INVENTION AND ADVANTAGES" is commensurate in scope to the independent claim; (pg. 10, ln 1-5)

storing **(14)** a duplicate set of all of the claims in the computer program, and creating the description by retrieving the duplicate set of claims under the heading "DESCRIPTION OF THE PREFERRED EMBODIMENT"; (pg. 10, ln 13-17)

searching for each occurrence of the word "said" in the duplicate set of claims copied into the specification, programming the computer program to replace the word "said" with the word "the" in the duplicate set of claims copied into the specification, and editing - the duplicate set of claims copied into the specification into grammatically correct sentence structure including adding verbs; (pg. 6, ln 16-22. pg. 10, ln. 17-22)

storing the element names in the computer program of the elements in the order recited in the duplicate set of claims, storing **(16)** in the computer program successive even numbers beginning with a number above the highest Figure number **(18)** to identify the respective element names, (pg. 12, ln 1-5) and searching **(20)** in the computer program for each occurrence of each respective element name in the order of occurrence in the duplicate set of claims and replacing each respective element name with that respective element name followed by successive ones of the even numbers to provide for the first time identifying reference numerals for the element names in the order of occurrence in the duplicate set of claims (pg. 12, ln 1-5) and automatically shifting the reference numerals in response to changing the order of occurrence in the duplicate set of claims; (pg. 7, ln 17-20)

adding each reference numeral to every showing of the element in the drawings; (pg. 12, ln 14-19)

selecting and storing **(22)** in the computer program abstract sentences including reference numbers from under the heading "DESCRIPTION OF THE PREFERRED EMBODIMENT" which most succinctly and specifically describe the elements shown in the drawings with a description of the elements in the "characterized by" clause commensurate with the specificity recited in dependent claims, and retrieving the abstract sentences under the heading "ABSTRACT OF THE DISCLOSURE"; and (pg. 7, ln. 21 et seq., pg. 12, ln 20 et seq.)

storing **(24)** in the computer program each reference numeral recited in the "CLAIMS" and in the "ABSTRACT OF THE DISCLOSURE" within parenthesis "( )", searching in the computer program and replacing each such reference numeral in the "CLAIMS" and in the "ABSTRACT OF THE DISCLOSURE" with the corresponding stored reference number within parentheses "( )". (pg. 8, ln 7-11, pg. 13, ln. 6-11)

Claim 20.   A computer program and a computer comprising:

a template memory **(10)** containing a document template containing headings equivalent to, (pg. 4, ln. 10 et seq.)

"BACKGROUND OF THE INVENTION

1)   Field of the Invention

2)   Description of the Prior Art

SUMMARY OF THE INVENTION AND ADVANTAGES

BRIEF DESCRIPTION OF THE DRAWINGS

DETAILED DESCRIPTION OF THE PREFERRED EMBODIMENT

CLAIMS

ABSTRACT OF THE DISCLOSURE";

a page break immediately before said heading "CLAIMS" in the computer program; and (pg. 5, ln. 1-3)

a page break separating said heading "ABSTRACT OF THE DISCLOSURE" from the remainder of said headings in the computer program; and (pg. 5, ln. 4-6)

a footer for displaying the attorney file identification in the margin of every page of the application; and (pg. 5, ln. 6-10)

the text,

"Other advantages of the present invention will be readily appreciated as the same becomes better understood by reference to the following detailed description when considered in connection with the accompanying drawings wherein:

Figure 1 is ;

Figure 2 is ;

Figure 3 is ;

Figure 4 is ; and

Figure 5 is ."

immediately after the heading "BRIEF DESCRIPTION OF THE DRAWINGS"; (pg. 5, ln. 15 et seq.);

the text,

"The invention has been described in an illustrative manner, and it is to be understood that the terminology which has been used is intended to be in the nature of words of description rather than of limitation.

Obviously, many modifications and variations of the present invention are possible in light of the above teachings. It is, therefore, to be understood that within the scope of the appended claims, wherein reference numerals are merely for convenience and

are not to be in any way limiting, the invention may be practiced otherwise than as specifically described."

before said page break preceding the heading "CLAIMS"; (pg. 5, ln. 11-17

and characterized by an independent claim processor **(12)** for duplicating and storing an independent claim under the heading "SUMMARY OF THE INVENTION AND ADVANTAGES" and for editing the duplicated independent claim copied under the heading "SUMMARY OF THE INVENTION AND ADVANTAGES" into grammatically correct sentence structure including changing "said" to "the" and adding verbs whereby the recitation under the heading "SUMMARY OF THE INVENTION AND ADVANTAGES" is commensurate in scope to said independent claim; (pg. 6 ln. 4-15)

a multiple claim processor **(14)** for duplicating and storing all of the claims under said heading "DESCRIPTION OF THE PREFERRED EMBODIMENT" for creating the description and for searching and replacing each occurrence of the word "said" in said duplicate set of claims copied under the heading "DESCRIPTION OF THE PREFERRED EMBODIMENT" with the word "the", and for editing said duplicate set of claims into grammatically correct sentence structure; (pg. 6 ln. 16 et seq.)

a reference number memory **(16)** for storing successive even numbers beginning with the number ten; (pg. 7 ln. 3 et seq.)

a Figure number memory **(18)** for receiving and storing the highest Figure number used to identify Figures of the drawings; (pg. 7 ln. 3 et seq.)

a reference number processor **(20)** (pg. 7 ln. 5 et seq.) responsive to said Figure number memory for storing the element names of the elements in the order recited in said duplicate set of claims and for searching and replacing each occurrence of each respective element name in the order of occurrence in said duplicate set of claims with said respective element name followed by successive ones of said even numbers beginning with

the first number ending in zero following the highest Figure number to provide for the first time identifying reference numerals for said element names in the order of occurrence in said duplicate set of claims and automatically shifting the reference numerals in response to changing the order of occurrence in the duplicate set of claims; (pg. 7 ln. 10-13)

an abstract processor **(22)** for selecting and storing abstract sentences including said reference numerals from under said heading "DESCRIPTION OF THE PREFERRED EMBODIMENT" and duplicating said abstract sentences under said heading "ABSTRACT OF THE DISCLOSURE"; and (pg. 7 ln. 21 et seq.)

a parenthesis processor **(24)** for automatically enclosing each reference numeral within parentheses in said claims and in said "ABSTRACT OF THE DISCLOSURE". (pg. 8 . ln. 8-13)

Claim 21. A method of preparing a patent application with a computer comprising the steps of:

storing **(10)** a document template in a computer program which contains headings equivalent to: (pg. 4, ln. 11 et seq. and pg. 8, ln. 16)

"SUMMARY OF THE INVENTION

DETAILED DESCRIPTION

CLAIMS

ABSTRACT";

drafting claims for specifically defining the novelty; and (pg. 9, ln. 10-18)

characterized by duplicating **(14)** at least one of the claims under the DESCRIPTION heading to make sure the description as created in the first instance uses the exact same terminology as used in the claims, (pg. 6, ln. 16-17 and pg. 10, ln. 13-17)

editing the duplicate claim copied under the DESCRIPTION heading into grammatically correct sentence structure, (pg. 10, ln. 21-22)

storing **(16, 18, 20)** the element name of the first element recited in the duplicate claim copied and edited under the DESCRIPTION heading and shown in the drawings with a first in a series of reference numerals, (pg. 11, ln. 8-22 and pg. 12, ln. 1-5)

searching for each occurrence of the first element name and replacing same with the first element name followed by the first reference numeral to provide a first identifying reference numeral for the first element name, (pg. 12, ln. 1-5)

storing the element name of the second element recited secondly in the duplicate claim copied and edited under the DESCRIPTION heading and shown in the drawings with the next sequential number in the series following the reference numeral used to identify the first element name, (pg. 7, ln. 3-17)

searching for each occurrence of the second element name and replacing same with the second element name followed by the next number to provide a second identifying reference numeral for the second element name, (pg. 7, ln. 3-17)

automatically shifting the reference numerals in response to changing the order of occurrence of the element names in the duplicate claim copied under the DESCRIPTION heading so that the elements are numbered in order of being first recited under the DESCRIPTION heading, and (pg. 7, ln. 17-20)

automatically shifting the reference numerals in response to interleaving an additional element into the duplicate claim copied under the DESCRIPTION heading for changing the order of occurrence of the elements names in the duplicate claim copied under the DESCRIPTION heading so that all numbered elements are numbered in order of being first recited under the DESCRIPTION heading. (pg. 7, ln. 17-20)

Claim 23.   The method as set forth in claim 21 wherein the step of storing **(18)** the element name of the first element recited in the duplicate claim copied and edited under the DESCRIPTION heading and shown in the drawings is further defined as using a

first in the series of reference numerals that is above the highest numeral used to identify a Figure in the drawings. (pg. 12, ln. 1-5)

Claim 26.   A computer program and a computer comprising:

a template memory **(10)** containing a document template containing the headings equivalent to: (pg. 4, ln. 10 et seq.)

"SUMMARY OF THE INVENTION

DETAILED DESCRIPTION

CLAIMS

ABSTRACT";

an independent claim processor **(12)** for drafting claims specifically defining the novelty and for duplicating at least one of the claims under the DESCRIPTION heading to make sure the description uses the exact same terminology as the claims as created in the first instance and for editing said duplicate claim into grammatically correct sentence structure; (pg. 6, ln. 4-15)

a reference number memory **(16, 20)** (pg. 7, ln. 5 et seq.) for storing the element name of the first element recited in the duplicate claim copied and edited under the DESCRIPTION heading and shown in the drawings with a first reference numeral in a series of reference numerals and for searching for each occurrence of the first element name and replacing same with the first element name followed by the first reference numeral to provide a first identifying reference numeral for the first element name and for storing the element name of the second element recited next in the duplicate claim copied and edited under the DESCRIPTION heading and shown in the drawings with the next sequential reference numeral in the series following the first reference numeral and for searching for each occurrence of the second element name and replacing same with the second element name followed by the next reference numeral to provide a second identifying reference numeral for

the second element name and for automatically shifting the reference numerals in response to changing the order of occurrence of the element names in the duplicate claim copied and edited under the DESCRIPTION heading so that the elements are numbered in order of being first recited under the DESCRIPTION heading and for automatically shifting the reference numerals in response to interleaving an additional element name into the duplicate claim copied under the DESCRIPTION heading for changing the order of occurrence of the element names in the duplicate claim copied and edited under the DESCRIPTION heading so that all numbered element names are numbered in the sequential order of being first recited under the DESCRIPTION heading. (pg. 7, ln. 3-20)

Claim 27.   A computer program and a computer as set forth in claim 26 including a Figure number memory (pg. 7, ln. 3 et seq.) for receiving and storing **(18)** the highest Figure number used to identify Figures of the drawings, said reference number processor being responsive to said Figure number memory for replacing the occurrence of the first recited element name in said duplicate claim with said respective element name followed by the first number ending in zero following the highest Figure number to provide identifying reference numerals for said element names in the order of occurrence in said duplicate claim under the DESCRIPTION heading to avoid duplicating a Figure number as a reference numeral.

The remaining claims 3, 10, 22, 24, 25 and 28 are dependent upon one of the above claims and are patentable therewith.

VI.   GROUNDS OF REJECTION

A.   Rejection Summary

Claims 1, 3, 10 and 19-28 are pending in the application. Claims 1, 19, 20, 21, and 26 are independent. Independent claims 1 and 26 and dependent claims 3, 21, and 22 stand rejected under 35 U.S.C. § 103(a) as being obvious over Petruzzi et al. (U.S. Patent No.

6,049,811) in view of Rivette et al. (U.S. Patent No. 5,754,840). Claims 10, 19, 20, 23, 24, 25, 27, and 28 are also rejected over Petruzzi in view of Rivette but further in view of Newman (U.S. Patent No. 5,774,833).

B.   Primary Rejection-Limitations in all Claims

The Petruzzi et al. '811 patent is relied upon to teach a method of drafting a patent application but, as admitted by the examiner, does not make any suggestion regarding automatically numbering elements in the order recited in the description let alone re-numbering when the order shifts. In addition, the Petruzzi et al. '811 Patent fails to teach that for which it is relied upon because it does not suggest the pre-step of copying the claims into the description section before applying reference numerals to element names; because the Petruzzi patent teaches drafting the description independently of the claims then "compares the words of the claims to the words in the Detailed Description . . . ." (see col. 16, ln. 9-17)

The Rivette et al. '840 patent is relied upon to compensate for the numbering of elements deficiency in the Petruzzi et al. '811 patent; however, Rivette et al. '840 also does not suggest numbering elements in the order recited in the description let alone automatically re-numbering when the order shifts. In contradistinction, Rivette et al. '840 teaches making a list of element numbers and the various element names used with those reference numbers so that the user can then manually edit the document. (Col. 15, ln. 52 through Col. 16, ln. 54 and claim 13, and as illustrated in Table 1 beginning in Col. 7, ln. 58, and in Fig. 10)

Neither does the Rivette et al. '840 patent suggest copying the claims into the description section as it teaches drafting the description independently of the claims then making a comparison of terms in the claims to the terms in the description. (as succinctly stated in Col. 9 ln. 7-17 and in claim 1)

These distinguishing limitations of adding the reference numerals in the order of elements recited in the copied claims defining the description are recited in all of the claims.

C. Supplemental Rejection Limitation in Claims 1, 19, 20, 23 and 27

The examiner also relies upon Rivette et al. '840 to teach using the first reference numeral above the highest Figure number. However, there is no suggestion whatsoever of such a step in Rivette et al. '840.

This limitation is specifically recited in claims 1, 19, 20, 23 and 27, from which claims 3 and 10 depend.

D. Limitation Not Separately Argued

The '833 patent to Newman was added to the Petruzzi et al. '811 and Rivette et. al. '840 combination for a teaching of placing reference numerals in parenthesis ( ) in the claims and abstract sections as specifically recited in claims 10, 19, 20, 24, 25 and 28. However, this rejection is not argued as the allowance of these claims relies upon the deficiencies in the primary references of Petruzzi et al. '811 and Rivette et al. '840 and will be allowed or rejected along with the claims from which they depend.

VII. ARGUMENT

A. Overview

1. Primary Distinguishing Limitations in all Claims

It is respectfully submitted that all of the claims may be grouped together in the primary argument because all of the impendent claims 1, 19, 20, 21 and 26 recite, inter alia, the patentable distinguishing limitations of:

> *associating the first element name with the first reference numeral to provide a first identifying reference numeral for the first element name under the DESCRIPTION and associating the second element name with a second identifying reference numeral for the second element name so that the elements are numbered in order of being first recited under the DESCRIPTION heading, and*

automatically shifting the reference numerals in response

to changing the order of occurrence of the element names under

the DESCRIPTION heading.

2. Supplemental Distinguishing Limitations in Claims 1, 19, 20, 23 and 27

In a supplemental and separate and further distinguishing argument, claims 1, 19, 20, 23 and 27, in addition to the above reference numbering, recite:

using a first in the series of reference numerals that is

above the highest numeral used to identify a Figure in the

drawings.

3. Remaining Claims

The remaining dependent claims 3 and 10 are allowable under the supplemental argument whereas 22, 24, 25 and 28 are allowable under the primary argument.

B. Primary Argument

1. Claims Recite Document Creation, Not Comparison

The subject invention is used in the <u>creation</u> of a patent application in contradistinction to the prior art methods that check for errors in the previously and independently created document. The subject method prevents errors from ever occurring in the first instance during creation of the application. This is a subtle but major and specific difference, particularly in the combination of steps. For example, the prior art is replete with methods of determining the erroneous use of different terminology (element names) for the same element and for the use of the same reference numeral on different elements or different terminology. On the other hand, the subject method makes sure that such errors do not occur as the application is being created.

2. Order and Re-order of Reference Numerals After Copying Claims

After the claims are copied into the description in accordance with the subject invention to make sure the exact same terminology (element name) is used in the description as in the claims, every occurrence of an element name is assigned a reference numeral and every occurrence of that element name associated with that reference numeral has that same reference numeral, and only that reference numeral. Most importantly, reference numerals are automatically applied and re-applied to the element names in the order of the element names being first recited in the description, and are re-numbered sequentially in the event that the order of being first recited changes. Accordingly, inconsistent or different element names and inconsistent use of element names with different reference numerals are avoided during the creation as distinguished from checking for such errors after the application is complete.

The examiner relies upon Rivette et al. '840 to modify Petruzzi et al. '811 on the basis that Rivette teaches the claimed assignment and re-assignment of reference numerals to element names. However, Rivette does not come close to applicant's claimed methodology. For example, applicant's claim 21 recites these steps:

> storing the element name of the first element recited in the duplicate claim copied and edited under the DESCRIPTION heading and shown in the drawings with a first in a series of reference numerals,
>
> searching for each occurrence of the first element name and replacing same with the first element name followed by the first reference numeral to provide a first identifying reference numeral for the first element name,
>
> storing the element name of the second element recited secondly in the duplicate claim copied and edited under the DESCRIPTION heading and shown in the drawings with the next sequential number in the series following the reference numeral used to identify the first element name,
>
> searching for each occurrence of the second element name and replacing same with the second element name followed by the next number to provide a second identifying reference numeral for the second element name,

automatically shifting the reference numerals in response to changing the order of occurrence of the element names in the duplicate claim copied under the DESCRIPTION heading so that the elements are numbered in order of being first recited under the DESCRIPTION heading, and . . .

The use of different terminology or different names for the same element is avoided by assigning the identical numeral to every occurrence of an element name in the description, thus eliminating the possibility for discrepancies in the assignation of reference numerals to element names, e.g., different terms applied to the same numeral, as in Rivette et al.

3. Teachings in Rivette et al. '840

In contrast, Rivette et al. '840 in col. 2, ln. 31, recites "[t]he invention is also very useful for *analyzing completed documents*" (emphasis added). Rivette et al. '840 teaches in col. 15, ln. 52 to col. 16, ln. 63 that the already created reference numeral is searched and the computer "assumes" that the element name or terms appearing immediately before the reference numeral comprises the element name corresponding to the reference numeral to be stored in the element index table. This is made clear in col. 16, lines 20-21 of Rivette '840 wherein it is stated that the computer "determines the element name for each reference number in the element index table." In other words, Rivette et al. '840 teaches searching for reference numerals already in the description and assumes terms preceding the reference numerals to be the element names.

The Rivette et al. system provides a list of the reference numerals used in the description and the respective element names assigned to the reference numerals whereby the user can observe inconsistencies in the element names and manually reconcile the discrepancies. Rivette et al. '840 explains in col. 14, ln. 61 et seq. that the user selects the previously authored reference numeral to display a list of element names or terms used with that selected reference numeral. Most importantly, as set forth in col. 16, ln. 28-60, the user

in the Rivette et al. system must edit discrepancies by changing the element names or terms used with the reference numerals.

Clearly, Rivette et al. produces a list displaying all of the various element names used in conjunction with every reference numeral recited in the description, See Figure 10. The user must manually analyze the list for inconsistencies in the reference numeral and element name pairs and must manually correct any discrepancies. In contradistinction, the subject invention provides a method in which a common reference numeral is assigned in a first use of the numeral to every occurrence of an element name in the description, thus eliminating the possibility for discrepancies in the reference numeral and element name pairs. Said another way, the subject invention assigns reference numerals to certain element names to facilitate the use of the reference numeral. A reference numeral cannot be used without assigning it to an element name.

4.   Prior Art Lack of Copying Claims Into Description

Not one reference suggests copying or duplicating the claims into the description followed by assigning reference numerals in the order of occurrence of the elements in the description, and only to element names selected by the user. This combination of steps is vital to avoiding errors during the creation of the application as distinguished from the manual checking and verification taught in the prior art.

Petruzzi '811 teaches the limitation of copying each independent claim into the summary to complete the summary of the invention (See col. 15, lines 25-30). However, this does not suggest copying a claim or a claim set into the description to make sure the exact same terminology (element names) is used in the description as in the claims. The examiner states "Petruzzi teaches the claimed limitation of copying the claims to summary which is part of specification." However, even though the summary and the description are both part of the specification, Petruzzi '811 distinguishes between the summary and the description and

specifically suggests copying the <u>independent</u> claims into the <u>summary</u> to summarize the invention rather than to make sure the exact same terminology (element names) is used in the description as the claims. There is simply no suggestion whatsoever in Petruzzi '811 to copy the <u>claims verbatim</u> into the <u>description</u>.

No reference numerals are used in the summary section; therefore, the pre-step of copying the claims into the description before assigning reference numerals is a critical combination. This critical combination is not suggested by the prior art.

The examiner also states "Petruzzi provides for a comparison of words in claims to detailed description and remind of missing words that provides the basis of copying the claims in the Detailed description" and refers to col. 16, lines 10-15. This does not provide for the basis of <u>copying</u> the claims into the description. Petruzzi '811 teaches a method that checks for errors in the previously and independently created document by comparing terminology in the description versus the claims. Petruzzi creates a list of every term used in the claims and a list of every term used in the description of an already competed document allowing the creator to compare the list for inconsistencies. Such a comparison is not a suggestion of copying claims into the description in the first instance.

In accordance with the subject invention, errors are prevented from ever occurring in the first instance during the creation of the application. See Petruzzi col. 16, lines 9-13, where "the computer compares the words of the claims to the words in the Detailed Description section and reminds the operator of any words in the claims not found in the detailed description." The examiner has not met the initial burden to provide some suggestion of copying a claim or a claim set into the <u>description</u> to make sure that the exact same terminology (element names) is used in the description as in the claims, particularly as pre-step to adding reference numerals to that exact same terminology.

5.   Automatic Shift of Reference Numerals

Although all of the claims clearly distinguish over the references by reciting the building of an element list and assigning reference numerals in the order of first recitation of the element names in the edited duplicate set of claims that build the description, the claims also recite, that, should the order of the elements in the edited duplicate set of claims forming the description be changed (from the order in the original duplicated claims), the reference numerals assigned to element names in the element list will <u>automatically shift in response to the change in the order of first recitation of the numbered elements in the description</u>. In Rivette et al. '840 a user must manually change the reference numerals both with various element names and order of use. There is no automatic shifting of reference numerals among element names in the prior art.

C.   Supplemental Argument

The examiner simply refers to "col. 1, lines 59-63, col. 14, 38-41 and also see table 1, col. 7, lines 55-col. 8, line 7" in Rivette et al. '840 for a teaching of limiting <u>reference numerals to digits above the highest Figure number</u>. However, not only are these lines devoid of any suggestion relating reference numerals to Figure numbers, but the entire Rivette et al. '840 patent is devoid of any such suggestion. Nor are any of the other references suggestive of this limitation.

Accordingly, claims 1, 3, 10, 19, 20, 23 and 27 are independently and additionally allowable.

D.   Detailed Understanding of Rivette et al. '840

In contradistinction to Rivette et al. '840, the subject invention creates the description with element names used in the claims and positively assigns reference numerals only to specific element names selected by the user so that the computer does not have to "assume" element names from terms already used. In other words, the subject invention assigns

reference numerals only to element names selected by the user, i.e., the element name is selected by the user before the reference numeral is assigned. The subject invention assigns a reference numeral to an element name whereas Rivette et al. '840 does the opposite by assigning element "names" to reference numerals, i.e., in Rivette et al. '840 a user manually inserts the reference numeral and thereafter the program determines and lists all of the element names the creator has used with that reference numeral. For example, Rivette et al. '840 teaches a method wherein a user could draft the following text in the description of a patent application, manually assigning reference numerals to the element names:

> A computer **10** aids a user to draft a patent application **12**. The program **10** searches the patent specification **12** for a reference numeral **14** in a detailed description **16** and stores the two preceding words as an element name **18**. The element **18** is stored alongside the reference numeral **14** in an index **20**.

The computer would then search the text for reference numerals and produce a list of the element names, the two words preceding the reference numeral, used in conjunction with the reference numerals:

Reference Numeral	Number of Occurrences	Element Name
10	2	A computer
12	2	patent application
10	2	The program
12	2	patent specification
14	2	reference numeral
16	1	detailed description

18	2	element name
18	2	The element
14	2	reference numeral
20	1	an index

According to the method disclosed in Rivette et al. '840, upon the production of such an element index table (as shown in Fig. 10), a user can view all of the different element names assigned to each reference numeral. When an error or discrepancy exists, as in the above example for reference numerals 10, 12, and 18, a user can only resolve the error or discrepancy by manually changing the element names in each occurrence in the specification so that an element name is consistently used throughout the description for every occurrence of a reference numeral.

On the other hand, the present invention provides a method wherein reference numerals are, in the first use, automatically assigned to the element names selected by the user and in the description of a patent application. Given the same description as above:

> A computer aids a user to draft a patent application. The program searches the patent specification for a reference numeral in a detailed description and stores the two preceding words as an element name. The element is stored alongside the reference numeral in an index.

wherein the user selects the element names "computer," "detailed description," "element name," "index," "patent application," and "reference numeral." The subject invention automatically assigns reference numerals to each and every occurrence of each respective element name in the order of first occurrence in the description to produce a description as follows:

A computer **10** aids a user to draft a patent application **12**. The program searches the patent specification for a reference numeral **14** in a detailed description **16** and stores the two preceding words as an element name **18**. The element is stored alongside the reference numeral **14** in an index **20**.

Additionally, the subject invention provides for automatically shifting the reference numerals in response to changing the order of first occurrence in the duplicate set of claims copied into the description. For example, a user modifies the above description to change the order of reciting "patent application **12**," "reference numeral **14**," and "detailed description **16**" as follows:

A computer **10** searches for reference numerals **14** in the detailed description **16** to aid a user in drafting a patent application **12**. The program stores the two words preceding the reference numeral **14** as an element name **18** in an index **20**.

However, before this can appear, the present invention will subsequently shift the reference numerals in response to changing the order of first occurrence of the element names in the description by searching for each occurrence of each respective element in the order of first occurrence in the description and replacing each respective element name with that respective element name followed by successive identifying reference numerals, thereby shifting the reference numerals in response to changing the order of first occurrence to re-number the order of <u>all</u> of the elements as shown in the following description:

A computer **10** searches for reference numerals **12** in the detailed description **14** to aid a user in drafting a patent application **16**. The program stores the two words preceding the reference numeral **12** as an element name **18** in an index **20**.

The examiner claims Rivette et al. '840 also teaches a method of shifting reference numerals in response to changing the order of occurrence. The examiner states:

Since the reference numbers are identified and modified with element name, it would also shift the reference numerals if order of occurrence changes as claimed because element name is inserted next to reference numbers and since each occurrence of element is searched based on element number as described in col. 14, lines 60-col. 15, lines 10. the sequence of elements may change or have

changed. In such a situation, the reference numerals for a given element automatically change.

Since Rivette et al. '840 teaches assigning element names to reference numerals manually inserted by a user, there is no way for the computer to <u>automatically shift</u> all of the reference numerals in response to a change in the order of occurrence of the element names. Changing the order of occurrence of the element names in Rivette et al. would <u>not</u> affect the remaining reference numerals. The reference numerals would have to be manually changed within the document in order for the computer to assign the element names to the proper reference numerals in order to shift the reference numerals to in response to changing the order of first occurrence. Therefore, the reference numerals for a given element will <u>not</u> <u>automatically shift</u>. For example, following the teachings of Rivette et al. '840, if a user initially enters the following text into the description of a patent application:

A computer **10** aids a user to draft a patent application **12**. The computer **10** searches the patent application **12** for a reference numeral **14**.

The computer would produce the following element index table:

Reference Numeral	Number of Occurrences	Element Name
10	2	A computer
12	2	patent application
10	2	The computer
12	2	patent application
14	1	reference numeral

If, following the teachings of Rivette et al. '840, the user modified the description of the

patent application without manually changing the reference numerals to read:

> A computer **10** searches for reference numerals **14** to aid a user in
> drafting a patent application **12**.

The element index table would subsequently display:

Reference Numeral	Number of Occurrences	Element Name
10	1	A computer
14	1	reference numerals
12	1	patent application

The element index table can be updated to reflect the changes in the description, but Rivette et al. '840 <u>will not automatically shift</u> the reference numerals in response to changing the order of occurrence.

The present invention <u>will automatically shift</u> the reference numerals in response to changing the order of occurrence of the element names in the duplicate set of claims. The examiner has incorrectly stated, "every occurrence of reference number will be replaced by reference element as claimed." The subject invention does not claim replacing the reference number with the reference element. The present invention is distinguished over Rivette et al. by <u>searching for each occurrence of each respective element in the order of occurrence in the</u> <u>duplicate set of claims, replacing each respective element name with that respective element</u> <u>name followed by successive identifying reference numerals, and automatically shifting the</u> <u>reference numerals in response to changing the order of occurrence in the duplicate set of</u> <u>claims.</u>

Furthermore, the examiner has stated:

> Rivette teaches a method of allowing user to identify the reference numbers and modify the element name. Word processor locate reference number and text or element name can be inserted next to reference numbers as described in col. 16, lines 47-52.

This is verified in Rivette et al. col. 16, lines 28-30 wherein "the present invention allows users to modify the elements names of reference numbers." However, assigning element names to reference numerals and allowing users to modify the element names is completely opposite to the assigning reference numerals to specific element names and re-assigning same in order of occurrence in accordance with the subject invention. The subject invention automatically assigns reference numerals to each occurrence of each respective element name to prevent errors from ever occurring during the creation of the application whereas Rivette et al. '840 teaches a method that compares and prepares a list of errors in the previously and independently created document.

E.   Summary

The examiner has failed to meet the burden of showing a clear path to obviousness, a path which must be as clear in the dark as in the light. The examiner makes many assumptions as to what would happen in accordance with the teachings of the references. The references teach comparing independently drafted claims and description and do not operate as the examiner suggests. Even if the references could be combined they would not produce the combination recited in the claims to create a patent application.
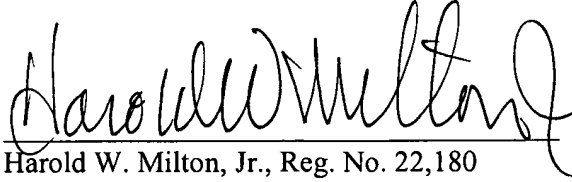
As to all of the claims, the references fail to suggest copying or duplicating the claims into the description followed by assigning reference numerals in the order of occurrence of the elements in the description, and only to specific element names.

Nor do the references suggest re-numbering the elements in response to changing the order of first recitation of the elements in the description.

In addition, Claims 1, 3, 10, 19, 20, 23 and 27 also recite the limitation of limiting the first reference numeral to a digit above the highest Figure number, and none of the references suggest this patentable distinction.

For these reasons, the reversal of the rejection of all of the claims is respectfully solicited.

Respectfully submitted,

Date: March 21, 2007

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VIII. CLAIMS APPENDIX

1. **(Previously Presented)**   A method of preparing a patent application with a computer comprising the steps of:

storing a document template in a computer program which contains headings equivalent to:

"BACKGROUND OF THE INVENTION

1) Field of the Invention

2) Description of the Prior Art

SUMMARY OF THE INVENTION AND ADVANTAGES

BRIEF DESCRIPTION OF THE DRAWINGS

DETAILED DESCRIPTION OF THE PREFERRED EMBODIMENT

CLAIMS

ABSTRACT OF THE DISCLOSURE";

storing a page break immediately before the "CLAIMS" heading in the computer program;

storing a page break immediately before the "ABSTRACT OF THE DISCLOSURE" heading in the computer program;

storing a footer in the computer program for displaying the attorney file identification on every page of the application;

composing by a user an independent claim in the computer program ending in a clause beginning with the words "characterized by" and reciting and isolating the novelty and preceded by at least one clause reciting prior art elements to the extent necessary to support and provide antecedent basis for the "characterized by" clause;

drafting claims in the computer ultimately dependent upon the independent claim for successively more specifically defining the patentable novelty; and

characterized by storing a duplicate set of all of the claims in the computer program, and creating the description by retrieving the duplicate set of claims under the heading "DESCRIPTION OF THE PREFERRED EMBODIMENT", searching for each occurrence of the word "said" in the duplicate set of claims copied into the specification, programming the computer program to replace the word "said" with the word "the" in the duplicate set of claims copied into the specification, and editing the duplicate set of claims copied into the specification into grammatically correct sentence structure including adding verbs, and assigning reference numerals for the first time by the steps of storing the element names of the elements in the order recited in the duplicate set of claims, storing successive numbers beginning with a number above the highest Figure number to identify the respective element names, and searching for each occurrence of each respective element name in the order of occurrence in the duplicate set of claims, replacing each respective element name with that respective element name followed by successive ones of said numbers to provide identifying reference numerals for the element names in the order of occurrence in the duplicate set of claims and automatically shifting the reference numerals in response to changing the order of occurrence in the duplicate set of claims.

3.   **(Previously Presented)**   The method as set forth in claim 1 including the steps of storing a duplicate of the independent claim in the computer program, retrieving the duplicate independent claim under the heading "SUMMARY OF THE INVENTION AND ADVANTAGES", and editing the duplicate independent claim copied under the heading "SUMMARY OF THE INVENTION AND ADVANTAGES" into grammatically correct sentence structure including changing "said" to "the" and adding verbs without adding further description whereby the "SUMMARY OF THE INVENTION AND ADVANTAGES" is commensurate in scope to the independent claim.

10. **(Previously Presented)** The method as set forth in claim 1 including the step of storing each reference numeral recited in the "CLAIMS" and in the "ABSTRACT OF THE DISCLOSURE" within parenthesis "( )", searching and replacing each such reference number in the "CLAIMS" and in the "ABSTRACT OF THE DISCLOSURE" with the corresponding stored reference number within parentheses "( )".

19. **(Previously Presented)** A method of preparing a patent application with a computer characterized by performing the following steps:

storing a document template in a computer program which contains headings equivalent to,

"BACKGROUND OF THE INVENTION

1) Field of the Invention

2) Description of the Prior Art

SUMMARY OF THE INVENTION AND ADVANTAGES

BRIEF DESCRIPTION OF THE DRAWINGS

DETAILED DESCRIPTION OF THE PREFERRED EMBODIMENT

CLAIMS

ABSTRACT OF THE DISCLOSURE";

storing a page break in the computer program immediately before the "CLAIMS" heading;

storing a page break in the computer program immediately before the heading "ABSTRACT OF THE DISCLOSURE";

storing a footer in the computer program for displaying the attorney file identification on every page of the application;

storing a Figure paragraph in the computer program immediately after the heading "BRIEF DESCRIPTION OF THE DRAWINGS";

storing a terminal paragraph in the computer program stating it is to be understood that reference numerals in the claims are merely for convenience and are not to be in any way limiting immediately before the page break before the heading "CLAIMS";

composing by a user an independent claim in the computer program beginning with the words "characterized by" and ending in a clause reciting and isolating the novelty and preceded by at least one clause reciting prior art elements only to the extent necessary to support and provide antecedent basis for the recitations in the "characterized by" clause;

composing by a user claims in the computer program ultimately dependent upon the independent claim for successively more specifically defining the novelty;

storing a duplicate of the independent claim in the computer program,

retrieving the stored independent claim under the heading "SUMMARY OF THE INVENTION AND ADVANTAGES", and editing the duplicate independent claim copied under the heading "SUMMARY OF THE INVENTION AND ADVANTAGES" into grammatically correct sentence structure including changing the word "said" to "the" and adding verbs without adding further description whereby the "SUMMARY OF THE INVENTION AND ADVANTAGES" is commensurate in scope to the independent claim;

storing a duplicate set of all of the claims in the computer program, and creating the description by retrieving the duplicate set of claims under the heading "DESCRIPTION OF THE PREFERRED EMBODIMENT";

searching for each occurrence of the word "said" in the duplicate set of claims copied into the specification, programming the computer program to replace the word "said" with the word "the" in the duplicate set of claims copied into the specification, and editing

the duplicate set of claims copied into the specification into grammatically correct sentence structure including adding verbs;

storing the element names in the computer program of the elements in the order recited in the duplicate set of claims, storing in the computer program successive even numbers beginning with a number above the highest Figure number to identify the respective element names, and searching in the computer program for each occurrence of each respective element name in the order of occurrence in the duplicate set of claims and replacing each respective element name with that respective element name followed by successive ones of the even numbers to provide for the first time identifying reference numerals for the element names in the order of occurrence in the duplicate set of claims and automatically shifting the reference numerals in response to changing the order of occurrence in the duplicate set of claims;

adding each reference numeral to every showing of the element in the drawings;

selecting and storing in the computer program abstract sentences including reference numbers from under the heading "DESCRIPTION OF THE PREFERRED EMBODIMENT" which most succinctly and specifically describe the elements shown in the drawings with a description of the elements in the "characterized by" clause commensurate with the specificity recited in dependent claims, and retrieving the abstract sentences under the heading "ABSTRACT OF THE DISCLOSURE"; and

storing in the computer program each reference numeral recited in the "CLAIMS" and in the "ABSTRACT OF THE DISCLOSURE" within parenthesis "( )", searching in the computer program and replacing each such reference numeral in the "CLAIMS" and in the "ABSTRACT OF THE DISCLOSURE" with the corresponding stored reference number within parentheses "( )".

20.   **(Previously Presented):**   A computer program and a computer comprising:

a template memory containing a document template containing headings equivalent to,

"BACKGROUND OF THE INVENTION

1) Field of the Invention

2) Description of the Prior Art

SUMMARY OF THE INVENTION AND ADVANTAGES

BRIEF DESCRIPTION OF THE DRAWINGS

DETAILED DESCRIPTION OF THE PREFERRED EMBODIMENT

CLAIMS

ABSTRACT OF THE DISCLOSURE";

a page break immediately before said heading "CLAIMS" in the computer program; and

a page break separating said heading "ABSTRACT OF THE DISCLOSURE" from the remainder of said headings in the computer program; and

a footer for displaying the attorney file identification in the margin of every page of the application; and

the text,

"Other advantages of the present invention will be readily appreciated as the same becomes better understood by reference to the following detailed description when considered in connection with the accompanying drawings wherein:

Figure 1 is ;

Figure 2 is ;

Figure 3 is ;

Figure 4 is ; and

Figure 5 is ."

immediately after the heading "BRIEF DESCRIPTION OF THE DRAWINGS";

the text,

"The invention has been described in an illustrative manner, and it is to be understood that the terminology which has been used is intended to be in the nature of words of description rather than of limitation.

Obviously, many modifications and variations of the present invention are possible in light of the above teachings. It is, therefore, to be understood that within the scope of the appended claims, wherein reference numerals are merely for convenience and are not to be in any way limiting, the invention may be practiced otherwise than as specifically described."

before said page break preceding the heading "CLAIMS";

and characterized by an independent claim processor for duplicating and storing an independent claim under the heading "SUMMARY OF THE INVENTION AND ADVANTAGES" and for editing the duplicated independent claim copied under the heading "SUMMARY OF THE INVENTION AND ADVANTAGES" into grammatically correct sentence structure including changing "said" to "the" and adding verbs whereby the recitation under the heading "SUMMARY OF THE INVENTION AND ADVANTAGES" is commensurate in scope to said independent claim;

a multiple claim processor for duplicating and storing all of the claims under said heading "DESCRIPTION OF THE PREFERRED EMBODIMENT" for creating the description and for searching and replacing each occurrence of the word "said" in said duplicate set of claims copied under the heading "DESCRIPTION OF THE PREFERRED

EMBODIMENT" with the word "the", and for editing said duplicate set of claims into grammatically correct sentence structure;

a reference number memory for storing successive even numbers beginning with the number ten;

a Figure number memory for receiving and storing the highest Figure number used to identify Figures of the drawings;

a reference number processor responsive to said Figure number memory for storing the element names of the elements in the order recited in said duplicate set of claims and for searching and replacing each occurrence of each respective element name in the order of occurrence in said duplicate set of claims with said respective element name followed by successive ones of said even numbers beginning with the first number ending in zero following the highest Figure number to provide for the first time identifying reference numerals for said element names in the order of occurrence in said duplicate set of claims and automatically shifting the reference numerals in response to changing the order of occurrence in the duplicate set of claims;

an abstract processor for selecting and storing abstract sentences including said reference numerals from under said heading "DESCRIPTION OF THE PREFERRED EMBODIMENT" and duplicating said abstract sentences under said heading "ABSTRACT OF THE DISCLOSURE"; and

a parenthesis processor for automatically enclosing each reference numeral within parentheses in said claims and in said "ABSTRACT OF THE DISCLOSURE".

21. **(Previously Presented)** A method of preparing a patent application with a computer comprising the steps of:

storing a document template in a computer program which contains headings equivalent to:

SUMMARY OF THE INVENTION

DETAILED DESCRIPTION

CLAIMS

ABSTRACT

drafting claims for specifically defining the novelty; and

characterized by duplicating at least one of the claims under the DESCRIPTION heading to make sure the description as created in the first instance uses the exact same terminology as used in the claims,

editing the duplicate claim copied under the DESCRIPTION heading into grammatically correct sentence structure,

storing the element name of the first element recited in the duplicate claim copied and edited under the DESCRIPTION heading and shown in the drawings with a first in a series of reference numerals,

searching for each occurrence of the first element name and replacing same with the first element name followed by the first reference numeral to provide a first identifying reference numeral for the first element name,

storing the element name of the second element recited secondly in the duplicate claim copied and edited under the DESCRIPTION heading and shown in the drawings with the next sequential number in the series following the reference numeral used to identify the first element name,

searching for each occurrence of the second element name and replacing same with the second element name followed by the next number to provide a second identifying reference numeral for the second element name,

automatically shifting the reference numerals in response to changing the order of occurrence of the element names in the duplicate claim copied under the DESCRIPTION heading so that the elements are numbered in order of being first recited under the DESCRIPTION heading, and

automatically shifting the reference numerals in response to interleaving an additional element into the duplicate claim copied under the DESCRIPTION heading for changing the order of occurrence of the elements names in the duplicate claim copied under the DESCRIPTION heading so that all numbered elements are numbered in order of being first recited under the DESCRIPTION heading.

22. **(Previously Presented)** The method as set forth in claim 21 including drafting the broadest independent claim ending in a novelty clause reciting and isolating the novelty and preceded by at least one clause reciting prior art elements to the extent necessary to support and provide antecedent basis for the novelty clause, storing a duplicate of the novelty clause in the computer program, retrieving the duplicate novelty clause under the heading SUMMARY OF THE INVENTION, and editing the duplicate novelty clause copied under the heading SUMMARY OF THE INVENTION into grammatically correct sentence whereby the SUMMARY OF THE INVENTION is commensurate in scope to the novelty clause in the broadest independent claim.

23. **(Previously Presented)** The method as set forth in claim 21 wherein the step of storing the element name of the first element recited in the duplicate claim copied and edited under the DESCRIPTION heading and shown in the drawings is further defined as using a first in the series of reference numerals that is above the highest numeral used to identify a Figure in the drawings.

24. **(Previously Presented)** The method as set forth in claim 21 including drafting an abstract under the ABSTRACT heading, and searching for each occurrence of each element name and replacing same with the respective element name followed by the assigned reference numeral to provide a reference numeral with the occurrence of each element name recited under the DESCRIPTION and CLAIMS and ABSTRACT headings.

25. **(Previously Presented)** The method as set forth in claim 24 including automatically adding parenthesis ( ) about each reference numeral recited in the CLAIMS and ABSTRACT headings.

26. **(Previously Presented)** A computer program and a computer comprising:

a template memory containing a document template containing the headings equivalent to:

SUMMARY OF THE INVENTION

DETAILED DESCRIPTION

CLAIMS

ABSTRACT

an independent claim processor for drafting claims specifically defining the novelty and for duplicating at least one of the claims under the DESCRIPTION heading to make sure the description uses the exact same terminology as the claims as created in the first instance and for editing said duplicate claim into grammatically correct sentence structure;

a reference number memory for storing the element name of the first element recited in the duplicate claim copied and edited under the DESCRIPTION heading and shown in the drawings with a first reference numeral in a series of reference numerals and for

searching for each occurrence of the first element name and replacing same with the first element name followed by the first reference numeral to provide a first identifying reference numeral for the first element name and for storing the element name of the second element recited next in the duplicate claim copied and edited under the DESCRIPTION heading and shown in the drawings with the next sequential reference numeral in the series following the first reference numeral and for searching for each occurrence of the second element name and replacing same with the second element name followed by the next reference numeral to provide a second identifying reference numeral for the second element name and for automatically shifting the reference numerals in response to changing the order of occurrence of the element names in the duplicate claim copied and edited under the DESCRIPTION heading so that the elements are numbered in order of being first recited under the DESCRIPTION heading and for automatically shifting the reference numerals in response to interleaving an additional element name into the duplicate claim copied under the DESCRIPTION heading for changing the order of occurrence of the element names in the duplicate claim copied and edited under the DESCRIPTION heading so that all numbered element names are numbered in the sequential order of being first recited under the DESCRIPTION heading.

27. **(Previously Presented)** A computer program and a computer as set forth in claim 26 including a Figure number memory for receiving and storing the highest Figure number used to identify Figures of the drawings, said reference number processor being responsive to said Figure number memory for replacing the occurrence of the first recited element name in said duplicate claim with said respective element name followed by the first number ending in zero following the highest Figure number to provide identifying reference

numerals for said element names in the order of occurrence in said duplicate claim under the DESCRIPTION heading to avoid duplicating a Figure number as a reference numeral.

28. **(Previously Presented)** A computer program and a computer as set forth in claim 26 including a subprocessor for automatically searching for each occurrence of each element name and replacing same with the respective element name followed by the assigned reference numeral with the occurrence of each element name recited under the CLAIMS and ABSTRACT headings along with adding reference numerals to the element names recited under the DESCRIPTION heading.

IX. EVIDENCE APPENDIX

A. Office Action Summary

Attached as Exhibit A.
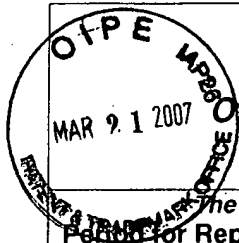
B. U.S. Patent No. 5,754,840 to Rivette et al.

Attached as Exhibit B.

C. U.S. Patent No. 6,049,811 to Petruzzi et al.

Attached as Exhibit C.

X. RELATED PROCEEDINGS APPENDIX

None

	Application No.		**Applicant(s)**	
Office Action Summary	09/273,021		MILTON, HAROLD W.	
	Examiner		**Art Unit**	
	Sanjiv D. Shah		2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _24 March 2006_.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1,3,10 and 19-28_ is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1, 3, 10, 19-28_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All   b)☐ Some * c)☐ None of:

   1.☐ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____.

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5)☐ Notice of Informal Patent Application (PTO-152)
6)☐ Other: _____.

DETAILED ACTION

1.   This action is in response to amendment filed on 3/24/2006. Claims 1, 3, 10, 19

and 20-28 remain in this application with claims 1, 19 and 20, 21 and 26 being

independent. Claims 21-28 are newly added.

Applicant's amendment clarified issues regarding 112 2nd rejection and therefore 112

rejection is withdrawn.

Claim Rejections - 35 USC § 103

2.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

3.   Claims 1, 3, 21, 22 and 26 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Petruzzi et al. (Patent # 6,049,811) in view of Rivette et al. (Patent #

5,754,840).

Regarding claims 1, 21, 26, Petruzzi teaches a *method of preparing patent application*

with a computer (See col. 2, lines 33-35, wherein a computer based patent application

drafting is taught)

Storing a document template in a computer program which contains headings

equivalent to "Background of invention, field of invention, description of prior art,

summary of invention, Brief description of drawings, Detailed description, claims and

abstract" (See col. 3, lines 13-18 and lines 26-32, wherein Petruzzi teaches storing the

information in computer and drafting application using various sections including claims,

summary, detailed description, etc.)

Storing a page break immediately before the claims heading in the computer program

and before the abstract heading (See col. 8, lines 4-7, wherein Petruzzi specifically

teaches inserting a page break when needed. Petruzzi also teaches accessing MPEP

rules as described in col. 6, lines 10-15. MPEP rules clearly instruct presenting abstract

and claims on separate pages. Therefore user would have been aware of inserting page

break before particular section)

Storing a footer in the computer program for displaying the attorney file identification on

every page of the application (See col. 16, lines 30-33, wherein Petruzzi teaches storing

footer as claimed)

Composing by a user an independent claim in the computer program ending in a clause

beginning with the words "characterized by" and reciting and isolating the patentable

novelty and preceded by at least one clause reciting prior art elements to the extent

necessary to support and provide antecedent basis for the "characterized by" clause

(See col. 12, lines 45-53, wherein Petruzzi teaches composing independent claims with

clause such as "comprising" or "comprising the steps" that have similar effect as of

claimed clause of "characterized by". MPEP clearly states that claims should be drafted

with necessary support and must provide for antecedent basis. Petruzzi also teaches

accessing MPEP rules as described in col. 6, lines 10-15)

Composing a user claims in the computer program ultimately dependant upon the

independent claim for successively more specifically defining the patentable novelty

(See col. 13, lines 14-27, wherein Petruzzi teaches the claimed invention of composing

dependant claims by adding clause "further comprising". MPEP states that dependant

claims further define patentable novelty. Petruzzi also teaches accessing MPEP rules

as described in col. 6, lines 10-15)

Characterized by storing duplicate set of all of the claims in the computer program, and

creating the description by retrieving the duplicate set of claims under the heading

"Description of preferred embodiment" (See col. 15, lines 25-30, wherein Petruzzi

teaches the claimed limitation of copying the claims to summary which is part of

specification. Also as described in col. 16, lines 10-15, Petruzzi provides for a

comparison of words in claims to detailed description and remind of missing words that

provides for the basis of copying the claims in the Detailed description) *searching for*

each occurrence of the word "said" in the duplicate set of claims copied into the

specification and replacing the word "said" with word "the" in the specification (See col.

13, lines 50-55, wherein Petruzzi teaches replacing "said" with "the" as claimed) *editing*

the claims into grammatically correct sentence structure including adding verbs (col. 5,

lines 64-col. 8, lines 8, Wherein Petruzzi teaches conventional spell check and

conventional editing. Grammatical check is also conventionally used in word

processing. Also see col. 16, lines 28-34. Also as described above Petruzzi teaches

replacing "said" with "the" as described in col. 13, lines 50-55, that in effect add verb

and makes grammatically correct structure)

Petruzzi teaches a drawings section and figures section as shown in fig 3, element 80

and 140. However Petruzzi specifically fails to teach *assigning reference numerals for*

the first time by the steps of storing the element names of the elements in the order

recited in the duplicate set of claims, storing successive numbers beginning with a

number above the highest Figure number to identify the respective element names, and

searching for each occurrence of each respective element name in the order of

occurrence in the duplicate set of claims, replacing each respective element name

with that respective element name followed by successive ones of said numbers to

provide identifying reference numerals for the element names in the order of occurrence

in the duplicate set of claims and automatically shifting the reference numerals in

response to changing the order of occurrence in the duplicate set of claims

In same field of endeavor, Rivette et al. does. Specifically Rivette et al. teaches

assigning reference numerals for the first time by the steps of storing the element

names of the elements beginning with a number above the highest Figure number to

identify the respective element names, (See col. 1, lines 59-63, col. 14, 38-41 and also

see table 1, col. 7, lines 55-col. 8, lines 7) and searching for each occurrence of each

respective element name in the order of occurrence in the duplicate set of claims, (col.

14, lines 60-col. 15, lines 4) replacing each respective element name with that

respective element name followed by successive ones of said numbers to provide

identifying reference numerals for the element names in the order of occurrence in the

duplicate set of claims (See col. 16, lines 28-60, wherein Rivette teaches a method of

allowing user to identify the reference numbers and modify the element name. Word

processor locate reference number and text or element name can be inserted next to

reference numbers as described in col. 16, lines 47-52. Since the reference numbers

are identified and modified with element name, it would also shift the reference

numerals if order of occurrence changes as claimed because element name is inserted

next to reference numbers and since each occurrence of element is searched based on

element number as described in col. 14, lines 60-col. 15, lines 10. the sequence of

elements may change or have changed. In such a situation, the reference numerals for

a given element will automatically change. Therefore every occurrence of reference

number will be replaced by reference element as claimed.

Therefore it would have been obvious for a person with ordinary skill in the art at the

time the invention was made to incorporate Rivette's method of editing reference

numbers with element name and comparing it with specification in the method of

Petruzzi because it provides user with ease of determining whether consistent

terminology exists in a document and for enabling user to easily modify the document

so as to achieve consistent terminology.

Regarding claims 3, 22, Petruzzi teaches the claimed invention of storing duplicate set

of claims under heading "summary" and editing the claims into grammatically correct

sentence structure including changing "said" to "the". (See col. 15, lines 25-30, wherein

Petruzzi teaches the claimed limitation of copying the claims to summary that is part of

specification. Also see col. 13, lines 50-55, wherein Petruzzi teaches replacing "said"

with "the" as claimed. Further in col. 5, lines 64-col. 8, lines 8, Wherein Petruzzi teaches

conventional spell check and conventional editing. Grammatical check is also

conventionally used in word processing. Also see col. 16, lines 28-34. Also as described

above Petruzzi teaches replacing "said" with "the" as described in col. 13, lines 50-55,

that in effect add verb and makes grammatically correct structure).

4.   Claims 10, 19, 20, 23, 24, 25, 27 and 28 are rejected under 35 U.S.C. 103(a) as

being unpatentable over Petruzzi et al. (Patent # 6,049,811) in view of Rivette et al.

(Patent # 5,754,840) as applied to claim 1 above, and further in view of Newman.

(Patent # 5,774,883).

Regarding claims 10, 24, 25, 28, Combination of Petruzzi and Rivette teaches the

claimed invention as described above with respect to claim 1. However Petruzzi and

Rivette fails to teach searching and replacing reference numerals in claims and abstract

within parenthesis

( ). However, Newman teaches verifying the abstract and verifying that the reference

numerals are within parenthesis as described in col. 13, lines 39-45. It is obvious that

verification must be performed by searching reference numerals and then verifying if

they are in parenthesis.

It would have been obvious for a person with ordinary skill in the art at the time the

invention was made to incorporate analyzing method of Newman in the method of

Petruzzi and Rivette because it aids in drafting patent application according to MPEP

rules.

Regarding claims 19, 20, 23 and 27, Petruzzi, Rivette and Newman teaches claimed

limitations as described above with respect to claim 1 and 10. As per additional

limitations Petruzzi teaches *storing figure paragraph under the heading Brief description*

of the drawings (See col. 14, lines 65-67. Since Petruzzi teaches adding phrases and

clauses as discussed above with respect to claim 1 above, it is obvious that one

ordinary skill in the art can insert and store claim terminal paragraph because it would

provide drafting as per MPEP rules).

It would have been obvious for a person with ordinary skill in the art at the time the

invention was made to incorporate Rivette's method of editing reference numbers with

element name and comparing it with specification in the method of Petruzzi because it

provides user with ease of determining whether consistent terminology exists in a

document and for enabling user to easily modify the document so as to achieve

consistent terminology.

Similarly, It would have been obvious for a person with ordinary skill in the art at the

time the invention was made to incorporate analyzing method of Newman in the method

of Petruzzi and Rivette because it aids in drafting patent application according to MPEP

rules.

Response to Arguments

5.   Applicant's arguments filed 3/24/2006 have been fully considered but they are

not persuasive.

Applicant argues that cited references, Specifically Rivette fails to teach claimed feature

of duplicating claims in to specification followed by assigning reference numerals in the

order of occurrence of the elements in the description. Applicant further argues that the

claims clearly distinguish over the references by reciting the building of an element list

and assigning reference numerals in the order of first recitation of the element in the

edited duplicate set of claims that build the description; and most importantly, that,

should the order of the elements in the edited duplicate set of claims forming the

description be changed (from the order in the original duplicated claims), the reference

numerals in the element list will shift in response to the shift in the order of first recitation

of the numbered elements in the description.

Examiner disagrees. Specifically applicant only distinguishes claimed invention over

Rivette reference but claims are rejected under combination of Petruzzi and Rivette and

further in view of Newman. Specifically duplicating claims in to specification is taught by

Petruzzi as described in the body of rejection (See col. 15, lines 25-30, wherein Petruzzi

teaches the claimed limitation of copying the claims to summary which is part of

specification. Also as described in col. 16, lines 10-15, Petruzzi provides for a

comparison of words in claims to detailed description and remind of missing words that

provides for the basis of copying the claims in the Detailed description). Therefore

applicant's argument is not persuasive. As per assigning reference numerals in the

order of occurrence of the elements in the description and assigning reference numerals

in the order of first recitation of the element in the edited duplicate set of claims that

build the description, Rivette teaches *(See col. 1, lines 59-63, col. 14, 38-41 and also*

see table 1, col. 7, lines 55-col. 8, lines 7) and searching for each occurrence of each

respective element name in the order of occurrence in the duplicate set of claims, (col.

14, lines 60-col. 15, lines 4) replacing each respective element name with that

respective element name followed by successive ones of said numbers to provide

identifying reference numerals for the element names in the order of occurrence in the

duplicate set of claims (See col. 16, lines 28-60, wherein Rivette teaches a method of

allowing user to identify the reference numbers and modify the element name. Word

processor locate reference number and text or element name can be inserted next to

reference numbers as described in col. 16, lines 47-52. Since the reference numbers

are identified and modified with element name, it would also shift the reference

numerals if order of occurrence changes as claimed because element name is inserted

next to reference numbers and since each occurrence of element is searched based on

element number as described in col. 14, lines 60-col. 15, lines 10. The sequence of

elements may change or have changed. In such a situation, the reference numerals for

a given element will automatically change. Therefore every occurrence of reference

number will be replaced by reference element as claimed. Therefore combination of

references teaches all claimed limitations.

In response to applicant's argument that the examiner's conclusion of

obviousness is based upon improper hindsight reasoning, it must be recognized that

any judgment on obviousness is in a sense necessarily a reconstruction based upon

hindsight reasoning. But so long as it takes into account only knowledge which was

within the level of ordinary skill at the time the claimed invention was made, and does

not include knowledge gleaned only from the applicant's disclosure, such a

reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

6.   Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.
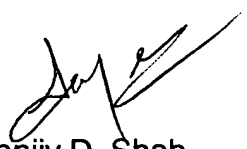
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sanjiv D. Shah whose telephone number is (571) 272-4098. The examiner can normally be reached on M-F 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew Bella can be reached on (571) 272-7778. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sanjiv D. Shah
Primary Examiner
Art Unit 2624

S. Shah
June 25, 2006